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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/813,852	03/07/97	DOCKERY R	21651.3

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EXAMINER	
BARTUSKA,F	
ART UNIT	**PAPER NUMBER**
3652	6

DATE MAILED: 03/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/813,852	R.L. DOCKERY et al
Examiner	**Group Art Unit**
F.J. BARTUSKA	3652

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on Dec. 21, 1998.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 2, 5, 6, 11, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taj in view of the "Retailing" publication. Taj discloses delivery of coupons in magazines and newspapers in col. 1, lines 26-49;

magazines and newspapers include non-product information attractive to customers. Taj does not disclose displaying the magazines or newspapers in the store. The "Retailing" publication discloses displaying magazines next to the check-out counter in lines 46-49 of the first column of page 19. It would have been obvious to one of ordinary skill in the art to display the magazines of Taj in a store in view of the showing and teaching of the "Retailing" publication.

3. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above. Further, merely calling for the store name and colors to be on coupons would involve only a notorious expedient of the art especially in the situation in which the coupon is for a brand which is exclusive to a store.

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above and further in view of Doane et al. Tai, as modified by the "Retailing" publication, shows all the features of the applicants' claimed invention except assembling a plurality of the coupons into a magazine. It would have been obvious to one of ordinary skill in the art in view of the magazine assembly of Doane et al to assemble a plurality of the publications of Tai into a magazine.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication as applied to claim 1 above. Further, it would have been obvious to one of ordinary skill in the art in view of the teaching on page 20 in lines 28-40 of the first column of the "Retailing" publication to include recipes in magazine advertisements of food, which advertisements include the coupons of Tai.

6. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tai in view of the "Retailing" publication and Doane et al as applied to claim 7 above. Further, merely calling for particular time periods between publications would involve only a notorious expedient of the art.

Response to Arguments

7. The applicant's remarks have been considered but have not been found persuasive in view of the art as now applied.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. Bartuska whose telephone number is (703) 308-1111.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Young, can be reached on (703) 308-1107. The fax phone number for this Group is (703) 305-7687.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [karen.young@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified exchanged unless there is of record an express waiver of the confidentiality requirements of 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published in the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

F. J. BARTUSKA 3/4/99
PRIMARY EXAMINER
GROUP 3100